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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194974
Party	Plaintiff Promark Brands Inc.
Correspondence Address	TIMOTHY P FRAELICH JONES DAY 901 LAKESIDE AVENUE CLEVELAND, OH 44114 UNITED STATES crdickson@jonesday.com
Submission	Motion to Compel Discovery
Filer's Name	Cecilia R. Dickson
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Signature	/Cecilia R. Dickson/
Date	03/02/2012
Attachments	Motion to Compel Expert Disclosure.pdf (17 pages)(876289 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PROMARK BRANDS INC., and H. J. HEINZ COMPANY,	**Opposition Nos. 91194974 and 91196358 (consolidated)**
Opposers,	U.S. Trademark Application 77/864,305 For the Mark **SMART BALANCE** Published in the Official Gazette on April 20, 2010
vs.	
GFA BRANDS, INC.,	
Applicant.	U.S. Trademark Application 77/864,268 For the Mark **SMART BALANCE** Published in the Official Gazette on August 10, 2010

PROMARK BRANDS INC. AND H. J. HEINZ COMPANY'S MOTION TO COMPEL EXPERT DISCLOSURE

I. INTRODUCTION

Traditionally, the Board does not countenance unexplained, extended delays in the discovery process. This Motion seeks to forestall further delay in these proceedings by seeking an order requiring Applicant GFA Brands, Inc. ("GFA") to provide any rebuttal expert disclosure and report that it intends to rely upon in these consolidated opposition proceedings by a date certain, or lose its ability to rely upon such testimony in these proceedings.

ProMark Brands Inc. and H. J. Heinz Company (collectively, "Heinz") timely filed an expert disclosure and report in these consolidated opposition proceedings on January 9, 2012. As of the date of this Motion, GFA has not provided any rebuttal expert disclosure, despite indicating that it intended to do so. GFA has indicated it cannot provide such information until May 1, 2012 – nearly 4 months after receipt of Heinz's expert disclosure. Such a delay far exceeds the date that discovery is currently set to close in these proceedings, and, as set forth in

greater detail below, no justifiable reason for such a long postponement of the conclusion of discovery has been provided by Applicant.

II. FACTUAL BACKGROUND

Opposition Number 91194974 was originally filed on May 20, 2010, and was eventually consolidated with Opposition Number 91196358 filed on September 2, 2010. Even though the original schedule set in the first-filed opposition indicated that discovery would close on January 25, 2011, discovery was still ongoing in these proceedings a year after that original deadline, as the result of several extensions. Discovery, however, appeared to be winding down as we entered January 2012. Corporate witnesses had been deposed or scheduled for deposition, documents were exchanged, and the deadline for expert disclosures drew near. On January 9, 2012, Heinz served its expert disclosure and expert report on GFA. GFA elected to not serve any expert disclosure. By operation of the TTAB rules, a rebuttal expert disclosure and report, if any, was due within 30 days of the filing of Heinz's expert disclosure.

On January 29, 2012, GFA identified an independent expert to whom it wanted to send certain deposition transcripts, pursuant to the terms of the Protective Order. Indeed, in one of those depositions, GFA asked one of Heinz's corporate representative questions about Heinz's expert report. Heinz consented to the release of the transcripts pursuant to the terms of the Protective Order. At no time prior to the filing of this Motion, however, has GFA disclosed this independent expert as a testifying expert.

Days after requesting the transcript disclosure, on February 3, 2012, GFA requested an extension of the rebuttal expert disclosure deadline and the discovery deadline, which at that time was set to close on February 7, 2012. Heinz agreed to a 30 day stay, based, in part, on the representation that within a week or so Heinz would have information on when to expect GFA's

rebuttal expert disclosure and report, and could proceed with scheduling and concluding expert discovery. *See* Exhibit 1. A stipulation was filed with the Board to that effect and a 30 day stay was granted. Two days after the Board granted the stay, on February 8, 2012, the Board, in response to a separate notification of Heinz's January 2012 expert disclosure, independently issued an order staying the proceedings "for the taking of expert discovery", and indicated that proceedings would resume on March 2, 2012, with discovery re-set to close on March 9, 2012.

Despite following up with GFA on more than one occasion, Heinz did not hear anything regarding even a proposal to schedule expert discovery until February 28, 2012. On February 28, 2012, with only days remaining until the proceedings resumed and with discovery set to close in a mere ten calendar days, GFA indicated that it would not be able to provide its rebuttal expert disclosure until May 1, 2012, and sought Heinz's approval for this extended stay. No specific reason was provided to justify such an extended stay, other than indicating that was when the expert believed s/he could complete the report. In essence, GFA would like to have roughly four times the amount of time provided in the rules to submit its rebuttal expert disclosure, without providing any specific, rational justification for such a long extension.

Heinz notified GFA the following day after receiving this proposal that it could not agree to such a lengthy stay without some justification for such an extended stay. *See* Exhibit 2. Heinz offered to agree to extend the discovery period by one additional month, and to give GFA an additional extension of two more weeks to complete its expert disclosures.

On March 1, 2012, GFA rejected that proposal. GFA indicated that the reason it wanted the stay was due to recently hiring an additional expert, and that that expert could not complete a report until May. *See* Exhibit 3. Even with this additional information, Heinz does not believe that such an extended delay is warranted based on the information provided to date. Despite

attempting to resolve this discovery dispute, the parties are at an impasse and require Board intervention. *See* Exhibit 4 (Affidavit of Cecilia R. Dickson). GFA's delay in retaining its expert does not justify the time GFA is requesting to complete its expert disclosures, especially in light of the fact that the deadline for the close of discovery has already been extended once by the Board for the purpose of conducting expert discovery.

III. FURTHER EXTENDED DELAY IS NOT PROPER.

While the Board makes clear that parties are to cooperate in the process of exchanging expert witness information and conducting discovery, the Board has also made crystal clear that mere delay in initiating discovery does not constitute good cause for an extension of the discovery period. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (TTAB 2008) (opposers' motion to extend discovery period denied where opposers did not serve written discovery requests until final day of discovery, and did not attempt to depose applicant during prescribed discovery period, and evidence does not support opposers' claim that they delayed discovery because parties were engaged in settlement discussions); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (no reason given why discovery was not taken during the time allowed). Here, at GFA's initiation and with Heinz's consent, the parties already had a 30 day extension granted to accommodate expert discovery. Heinz is not aware of any circumstances that would justify further extensions of the expert discovery period.

Moreover, to the extent GFA maintains that an additional 60 days of time is needed on top of the 60 days it has already been granted to prepare its rebuttal expert disclosures because it has only recently retained its expert, such late retention should not prejudice Heinz. Moreover, Heinz has already agreed to a reasonable 30 day extension – the same amount of time separately ordered by the Board for purposes of accommodating expert discovery – to allow GFA to

complete its rebuttal expert disclosure. Heinz was even willing to extend the schedule a bit more to accommodate the parties. However, seeking nearly four months to complete this process far exceeds a reasonable period of time to conduct discovery, and thus, should be refused.

IV. CONCLUSION

Heinz has attempted to find a resolution to this issue that would allow for all parties to complete discovery on a reasonable timeframe. Based on the information provided to date by GFA, there is no basis for seeking further delay for purposes of completing expert discovery. Any need for such a long period of time appears to be due to GFA's delay in retaining its expert. Heinz should not be required to suffer the consequences of GFA or its proposed expert's lack of diligence in arranging for a timely rebuttal. Thus, Heinz moves that GFA be ordered to provide any rebuttal expert disclosure no later than March 16, 2012.

Dated this 2nd day of March, 2012.

Respectfully submitted,

Cecilia R Dickson

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Attorneys for Opposers

EXHIBIT 1

Subject:
Promark v GFA

From:
Cross, David R.
02/03/2012 10:57 AM

To:
'Cecilia R Dickson'

Cc:
"Levine, Marta S.", "Wilbert, Johanna M."
Show Details

History: This message has been replied to and forwarded.

Cecilia,

As you know, we will be naming an expert or experts in response to your expert designation and survey report, but would ask that you consent to more than the 30 days allotted under Rule 26(2)(D)(ii) for such responsive expert disclosures. We also would need to extend the 2/7 discovery close to complete expert discovery following the disclosures. Here are my thoughts about how to handle this.

The TBMP makes clear that the parties are to cooperate in the process of exchanging expert witness information, and I assume you would do so any way given the professional way you have handled this proceeding (I know, flattery will get me no where....). What I propose is that we consent to the extensions needed to allow each side adequate time to address expert witness testimony.

Unfortunately, although we have retained one expert that I have identified to you already, we do not yet know when we will be in a position to provide a full expert report or reports. We should be able to have more complete information about timing in a week or so.

Given the 2/07 discovery close now on the schedule, I propose that we agree to suspend the schedule for, say, 30 days to allow us to put together a thoughtful schedule for completing discovery. We can exempt from the suspension our answers to your recent requests to admit, if you would like.

Give the impending 2/07 date and 30 day deadline for disclosing responsive experts, I would appreciate your thoughts about this as soon as possible. Thank you.

David R. Cross
Partner
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EXHIBIT 2

JONES DAY

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crdickson@JonesDay.com

JP008682:tsh/1245383
931063-205019

February 29, 2012

VIA ELECTRONIC MAIL

David R. Cross, Esq.
Quarles & Brady LLP
411 East Wisconsin Avenue
Milwaukee, WI 53202

Re: Promark Brands Inc. and H.J. Heinz Company vs. GFA Brands, Inc.

Dear David:

This letter follows up our conversation yesterday regarding your proposal to further extend the discovery period, such that GFA Brands, Inc. would not provide its expert disclosure and rebuttal expert report until May 1, 2012. We simply cannot agree to such a long extension, particularly where we have not been provided with any reason necessitating an extension of this duration. In marked contrast, we were quite prompt in disclosing the information pertaining to our expert.

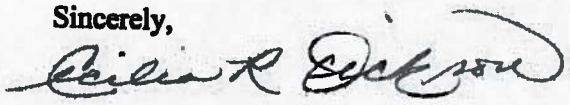
For example, you will recall that we served our expert disclosure and expert report on January 9, 2012. By operation of the TTAB rules, a rebuttal expert disclosure and report is due within 30 days. On January 29, 2012, you identified an independent expert to whom you wanted to send certain deposition transcripts, pursuant to the terms of the Protective Order. Indeed, in one of those depositions, you had asked one of our corporate representative questions about our expert report. We consented to the release of the transcripts pursuant to the terms of the Protective Order. At no time, however, have you disclosed this independent expert as a testifying expert. On February 3, 2012, you requested an extension of the rebuttal expert disclosure deadline and the discovery deadline, which at that time was set to close on February 7, 2012. We agreed to a 30 day stay, based, in part, on the representation that within a week or so we would have information on when to expect your rebuttal expert disclosure and report, and could proceed with scheduling and concluding expert discovery. A stipulation was filed with the Board to that effect and a 30 day stay was granted. Two days later, on February 8, 2012, the Board, in response to the separate notification of our January 2012 expert disclosure, independently issued an order staying the proceedings "for the taking of expert discovery", and indicated that proceedings would resume on March 2, 2012, with discovery re-set to close on March 9, 2012. Despite following up with you a couple of times, until yesterday, we did not hear anything regarding even a proposal to schedule expert discovery since the opposition

proceeding was stayed. As of the date of this letter, no disclosure or any other expert-related discovery materials have been provided by you to us.

While the Board makes clear that parties are to cooperate in the process of exchanging expert witness information and conducting discovery, the Board has also made clear that mere delay in initiating discovery does not constitute good cause for an extension of the discovery period. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (TTAB 2008) (opposers' motion to extend discovery period denied where opposers did not serve written discovery requests until final day of discovery, and did not attempt to depose applicant during prescribed discovery period, and evidence does not support opposers' claim that they delayed discovery because parties were engaged in settlement discussions); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (no reason given why discovery was not taken during the time allowed). Given the already extended discovery period in this opposition to accommodate document production and fact witness depositions, further broad, unexplained extensions of time to conduct expert discovery do not, based on the information we have received to date, appear warranted.

Accordingly, in an effort to resolve this matter without the need to resort to the Board for relief, we will entertain any counter-proposal to reset the deadlines to a more reasonable time frame until March 5, 2012. We will not consider anything greater than a 30 day extension resetting the close of discovery to April 9, 2012, with your rebuttal expert disclosure due no later than March 16, 2012. If we are unable to reach agreement, we will have no choice but to avail ourselves of relief from the Board.

Sincerely,



Cecilia R. Dickson

cc: Marta S. Levine, Esq.
Johanna M. Wilbert, Esq.
Timothy P. Fraelich, Esq.

EXHIBIT 3

Subject:
RE: Heinz v. GFA: Expert discovery scheduling

From:
Cross, David R.
03/01/2012 10:39 AM

To:
Cecilia R Dickson

Cc:
"Levine, Marta S.", "Wilbert, Johanna", Timothy Fraelich
Show Details

1 Attachment

image001.gif

I do not have time now respond to everything in your letter at this point, other than to say we disagree, including disagreeing that I supposedly gave no reason for the schedule I proposed or the implication that we are seeking a delay merely for delay's sake. As I explained on the 28th, the additional expert we have searched for and have just recently retained cannot complete a thorough analysis of your survey and prepare a report until about May 1. As you assumed without prompting during our call on the 28th, the specifics of what he plans to do are work product. We should not be required to disclose those specifics before our testifying expert reports are due.

Is there any chance that you would reconsider your position and agree to the May 1 date for us to disclose any rebuttal exert reports?

Thanks.

Dave

From: Cecilia R Dickson [mailto:crdickson@JonesDay.com]
Sent: Wednesday, February 29, 2012 4:25 PM
To: Cross, David R. (MKE x1669)
Cc: Levine, Marta S. (MKE x1675); Wilbert, Johanna M. (MKE x1495); Timothy Fraelich
Subject: Heinz v. GFA: Expert discovery scheduling

David- Please see the attached letter following up on our discussion yesterday.

Cecilia

JONES DAY | **Cecilia R. Dickson**

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EXHIBIT 4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PROMARK BRANDS INC. and H. J. HEINZ COMPANY,	)	**Opposition Nos. 91194974 and 91196358**
Opposers,	)	U.S. Trademark Application 77/864,305 For the Mark **SMART BALANCE** Published in the Official Gazette on April 20, 2010
vs.	)	
GFA BRANDS, INC.,	)	U.S. Trademark Application 77/864,268 For the Mark **SMART BALANCE** Published in the Official Gazette on August 10, 2010
Applicant.	)	

AFFIDAVIT OF CECILIA R. DICKSON

My name is Cecilia Dickson and I am an associate at Jones Day. My office is located at 500 Grant Street, Suite 4500, Pittsburgh, Pennsylvania 15219.

I am one of the attorneys representing Opposers in the consolidated opposition proceeding set forth above.

I hereby certify that the statements contained in the attached Motion to Compel are true and correct, to the best of my knowledge, and that the statements in the Motion recount the discussions I had with counsel for Applicant to resolve our discovery dispute.

I further hereby certify that Opposers have made a good faith effort, by both conference and correspondence, to resolve with the Applicant's attorney the issues presented in this Motion to Compel.

The parties were unable to resolve their differences, thereby necessitating this Motion to Compel.

Dated this 2nd day of March, 2012.

By: Cecilia R Dickson
Cecilia R. Dickson

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing was sent by ordinary U.S. mail, postage prepaid, with a courtesy copy via email, on this 2nd day of March, 2012, to Counsel for Applicant:

Marta S. Levine
David R. Cross
Johanna M. Wilbert
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Attorney for Opposers